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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Donald E. Weder)	Group Art Unit: 1775
)	
Serial No.: 09/764,365)	Examiner: S. Stein
)	
Filed: January 18, 2001)	Atty. Dkt. No.: 8403.186
)	
Reissue of: U.S. Pat. No. 5,861,199)	
)	
Issued: January 19, 1999)	
)	

For: OPTICAL EFFECT MATERIAL AND METHODS

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Commissioner of Patents
P.O. Box 1450
Alexandria, VA 2231-1450

Petition to Invoke the Supervisory Authority of the Commissioner
Pursuant to 37 C.F.R. 1.181(a)(3) to hold "Termination of
Proceedings" in abeyance pending decision by the Board

Sir:

In response to the Decision Terminating Proceedings mailed June 2, 2004, the Applicant, pursuant to 37 C.F.R. 1.181(a)(3), herein responds as follows.

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Statement of Facts

On September 20, 1996 the Applicant filed U.S. Application 08/717,469. Application '469 inadvertently referred back in the continuing data to U.S. Application No. 06\613,080 filed May 22, 1984. Application '469 issued into U.S. Patent No. 5,861,199 on January 19, 1999. On January 18, 2001 the Applicant filed his reissue application No. 09/764,365. The error upon which this reissue was based was that the patent was partly inoperative or invalid because it incorporated or referenced back to prior co-pending and historical "family tree" type references further than required for patentability, resulting in an unfairly lost patent term.

The inclusion of this "continuing data" was a holdover from the Applicant's previously harmless pre-GATT practice of including all family members solely for the purpose of informing the public of other related applications and patents. This purely discretionary non-substantive former practice now threatens to make this patent wholly or partly inoperative or invalid. Since this continuing data could have been eliminated at any time during the pendency of the application, it follows that the failure to do so, without deceptive intent, is an error that should be corrected through reissue proceedings. Thus, the Applicant seeks to amend the "Related U.S. Application Data" so as to read as follows:

This application is a reissue of U.S. Application No. 08/717,469 filed September 20, 1996, now U.S. Patent No. 5,861,199, which is a

continuation in part of U.S. Application No. 08/454,474, filed May 30 1995, now U.S. Patent No. 5,701,720, which is a continuation of U.S. Application No. 08/179,057, filed January 7, 1994, now U.S. Patent No. 5,576,089.

If the Applicant is not allowed to amend the continuing data the patent will have expired on May 22, 2004.

On May 28, 2004 the Examiner mailed a non-final office action rejecting all the claims in the reissue application on the basis that the USPTO is authorized to grant a reissue patent only to correct a patent deemed wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent. In support thereof the examiner relied upon *inter alia*, 35 U.S.C. § 251 and In re Morgan 990 Fed 1230, 26USPQ2d 1392 (Fed. Cir. 1993).

Previously, on May 29, 2002 in reissue Application No. 09/678,217 (which referenced this reissue application and included the same issues as this reissue application) the Applicant had filed a Notice of Appeal to the Board of Patent Appeals and Interferences. Oral hearing was set on February 5, 2004. After oral argument the Board of Patent Appeals and Interferences remanded reissue application '217 back to the Examiner for further consideration and directed the Examiner to either furnish a supplemental Examiner's answer to the argument set forth in the Applicant's reply brief or take other appropriate action (e.g., withdraw the rejection).

On March 10, 2004 in the '217 reissue Application the Examiner

determined the "other appropriate action" to be taken was to reopen prosecution and enter a new rejection under 35 U.S.C. § 251. More specifically, the Examiner in that case stated:

Upon further consideration, it is determined that **the other appropriate action to be taken in the above-identified reissue application is to reopen prosecution** under 37 CFR 1.193(b)(1) to enter a new rejection of claims 1 through 38 under U.S.C. § 251.

Claims 1 through 38 are rejected under 35 U.S.C. §251 on the basis that the changes being sought by reissue would not correct a patent "deemed wholly or partly inoperative or invalid within the meaning of 35 U.S.C. §251. The Director is authorized to reissue a patent only when a "patent is, through error without deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less then he had a right to claim in the patent" See 35 U.S.C. §251, ¶1...

Thus, the Examiner withdrew the previous "gatekeeper" rejection but maintained the same grounds of rejection as before but now in the "prosecution" stage of the reissue application. The Examiner further stated that because prosecution had been reopened in reissue application '217 the Applicant must exercise one of the following two options to avoid abandonment. 1) file a reply under 37 CFR 1.111 or 2) request reinstatement of the Appeal. Applicant has elected to request reinstatement of the Appeal in U.S. Application No. 09/678,217. The Applicant anticipates a similar rejection in this reissue application. In anticipation of a similar rejection in this reissue application, the Applicant also requests reinstatement of the appeal in reissue application '365.

Applicant's Request to Reinstate Appeal and Supplemental Appeal Brief is attached hereto as Applicant's Exhibit 1.

On June 2, 2004 in reissue application '365, the USPTO also mailed a "DECISION TERMINATING PROCEEDINGS". The "DECISION TERMINATING PROCEEDINGS" set forth that the USPTO was terminating the proceedings because the term of U.S. Patent No. 5,861,199 expired on May 22, 2004. The USPTO also relied on 35 U.S.C. § 251 and *In re Morgan* 990 and 1230 26USPQ2d (Fed. CR. 1997). The Decision Terminating Proceedings specifically set forth that:

This is not a final agency action within the meaning of 5 U.S.C. § 704. Any request for further review of this matter must be made by way of petition under 37 CFR 1.181(a)(3).

Since proceedings in the above-identified reissue application are hereby terminated, the above identified application will be forwarded to Technology Center 3700 for processing as an abandoned application.

On July 14, 2004 the Examiner also mailed a "Notice of Abandonment" to Applicant's counsel. It is from this Decision Terminating Proceeding and this Notice of Abandonment, that the Applicant now petitions the Commissioner.

Points to Be Reviewed

Whether the Commissioner should hold the "Termination of Proceedings" and the "Notice of Abandonment" in abeyance pending a decision by the Board on the issue of whether an incorrect priority claim in an issued patent may be

corrected during a reissue application pursuant to 35 U.S.C. § 251 and 37 C.F.R. § 1.171; i.e. whether an oath/declaration incorrectly claiming priority is a type of error that will support a reissue application.

Action Requested

Applicant requests the "Termination of Proceedings" and "Notice of Abandonment" be held in abeyance pending a final decision of the Board and also pending any necessary additional proceedings (e.g. Appeal from the Board's decision to the Court of Appeals for the Federal Circuit) arising therefrom.

Brief in Support

The Examiner relies on In re Morgan, 990F.2d 1230, 26USPQ2d 1392 (Fed. Cir. 1993) in support of the Examiner's Decision Terminating Proceedings and his proposition that the director has authority to reissue a patent only "for the unexpired term of the original patent". In re Morgan is clearly distinguishable from the present reissue application. In re Morgan involved a situation wherein Morgan attempted to reissue U.S. Patent No. 3,900,645 four different times. Morgan filed his first reissue application in 1977 under the then existing "no defect" rule. The Board of Appeals affirmed the rejection of Morgan's unamended claims and the Court of Customs and Appeals affirmed. Morgan then filed a continuation reissue application and later abandoned it. Three years later Morgan filed a third reissue application with an amended claim

1. The Board then affirmed a rejection over the same references relied upon in the first reissue. Morgan did not appeal and in 1989 Morgan filed a fourth reissue application with claim 1 amended in a different manner from that in the previous application and added a new independent claim 5. The Board affirmed a 35 U.S.C § 112 rejection, a 35 U.S.C. § 103 rejection based upon the same references relied upon in the previous applications and a 35 U.S.C. § 251 rejection for new matter. The patent expired on August 19, 1992 while the appeal was pending and on October 7, 1992 the Commissioner moved to dismiss the appeal arguing that there is no "unexpired" term for which it has authority to reissue the patent and that the case was moot. The Court granted the motion.

Unlike the present reissue application, at no time in In Re Morgan was the erroneous inclusion of continuing data or the determination of the "unexpired term of the patent" at issue. Rather, Morgan simply ran out of time to correct other errors that had no relationship to how the actual term of the patent was to be calculated.

The very issue the Applicant has sought to resolve, via the present reissue application, is the true scope of the "unexpired" term of the Patent. In fact, the Board in its first review of this issue implied that amendment of the continuing data is an error that can be remedied via a reissue application, in that, the Board did remand the reissue application to the Examiner to either furnish a supplemental Examiner's answer or take other appropriate action

(e.g., withdraw the rejection). If the Applicant's analysis is accurate and the defect sought to be corrected is indeed corrected, the "unexpired" term of the patent is until Jan 7, 2014. If the "Decision Terminating Proceedings" is allowed to stand, the very error Applicant sought to correct will be used to preempt the Board's authority to decide the legal issue for which the reissue application was sought. The Applicant respectfully submits that he should be permitted his day before the Board and allowed full judicial resolution of these issues. Indeed, as there is no case law on point with respect to the issues on appeal, a substantive resolution of the issues on the merits would best serve all interested parties – the Applicant, the USPTO and the public at large.

35 U.S.C. §251 provides for the reissue of an application where "a patent is, through error without any deceptive intention, deemed inoperative or invalid, by reason of a defective specification or drawing, or by the patentee claiming more or less than he had a right to claim in the patent." (Emphasis added) Thus, the purpose of the reissue statute is to correct any defect in the original patent which crept into the patent without any deceptive intent on the part of the patentee that impairs the patentee's rights. In order to obtain a reissuance of a patent, a patentee must meet five basic requirements: (1) the patent must be deemed wholly or partly inoperative or invalid due to a defect; (2) the defect arose through error and without any deceptive intent; (3) the reissue sought does not introduce "new matter"; (4) enlarging reissues must be filed within 2 years from issuance; and (5) the subject matter claimed in the reissue

application meets the requirements of patentability. *Chisum on Patents*, 4:15.03, page 15-31. In the instant case, all the requirements of patentability are met.

The Applicant is merely attempting to correct an erroneous claim of priority and, consequently recapture the full and rightful original term of the issued patent. The Applicant's use of the reissue statute to correct such an error is appropriate and well within the scope of the statute.

The resolution of this action turns on a legal question of statutory construction. A remedial statute must be interpreted broadly in order to effectuate its purpose. The reissue statute's main purpose is to allow Applicants to correct mistakes that unnecessarily limit the scope of patent protection to which they are legally entitled. Unnecessary priority information that was not required for patentability was mistakenly included in U.S. Patent No. 5,861,199 (the '199 patent), as originally issued, without deceptive intent on the part of the Applicant. Pursuant to 35 U.S.C. § 251, such a mistake or error resulted in (1) an error which rendered the patent wholly or partly inoperative, and (2) cause a severe, unjustifiable, and inequitable loss of patent protection - i.e. substantially and unnecessarily shortened term. The correction of the error in the '199 patent would merely reinstate the full original term to which the Applicant is entitled. Such an outcome is surely equitable and well within the goals and purposes of the reissue statute.

Pursuant to 35 U.S.C. § 154, the '199 patent is entitled to a term of 20

years from the priority date that is necessary for patentability. The term of a patent is defined by 35 U.S.C. 154, as that which the Applicant was and is entitled and is the "term of the original patent." Without the error of which the Applicant complains, the original term of the patent would be 20 years from January 7, 1994.

Direct and special evidence that the Applicant unintentionally and inadvertently included erroneous continuing data, that was not necessary for patentability, is of record and is uncontested. At no time was the Applicant attempting to gain advantage of the May 22, 1984 date. The Information Disclosure Statement filed by the Applicant shows approximately 31 patents having issue dates after the May 22, 1984, the "filing date" or "priority date" alleged by the Applicant as being erroneous. Furthermore, the 31 patents with issue dates after May 22, 1984 were apparently considered by the Examiner since the Examiner initialed that he considered such patents on the PTO form 1449 and such patents were mentioned under the "References Cited" section in the issued patent.

Thus, the original term of the '199 must necessarily be calculated from the priority date that is required for patentability - i.e. January 7, 1994. The Applicant is seeking to correct this error and thus obtain the original term of the '199 patent to which he is entitled.

The Congressional purpose behind 35 U.S.C. §251 is to prevent correctable errors from "forever depriv[ing] a patent Applicant of a priority right

to which he would otherwise be entitled.” *Brenner v. State of Israel*, 400 F.2d 789, 791 (1968). Though *Brenner* is not specific to the unique situation that has arisen in the present case, *Brenner* is directly on point and instructive with respect to a scenario in which the Applicant received less than he was entitled due to an incorrect claim of priority.

The Applicant’s inadvertent and mistaken reference to earlier applications significantly and unnecessarily reduced the patent term (i.e. the original patent term) to which the Applicant was otherwise entitled. If the cross-reference section in the ‘199 patent were properly corrected through this reissue application, the Applicant would be granted the patent that is guaranteed by 35 U.S.C. § 154 . The legislative history makes it clear that equity shall guide 35 U.S.C. § 251 actions. See e.g. *Sampson v. Commissioner of Patents*, 195 U.S.P.Q. 136, 136 (D.D.C. 1976). An easily correctable error is keeping the Applicant from fully enjoying the full original patent term to which he is entitled.

MPEP § 1402 also pointedly states that failure to make reference to or incorrectly making reference to prior copending applications are errors that may be corrected by reissuance under 35 U.S.C. § 251. The language of MPEP § 1402 is clear, unambiguous, and on point.

Case law, statutes, and legislative history of both 35 U.S.C. §§ 154 and 251 support and mandate the correction of an incorrect claim of priority through the use of a reissue application. Applicant respectfully submits that there is in fact no extension of the “original term of the patent”; rather, the

Applicant is merely attempting to obtain the full original term of the patent he was entitled to pursuant to 35 U.S.C. § 154. If the Decision Terminating Proceeding is allowed to stand, the Applicant will be left without recourse to correct an error that left him with an all but worthless patent, an error that essentially destroys his statutory right to exclude others from making, using, and selling his claimed invention. Such a result is inequitable, contrary to both the letter and the spirit of 35 U.S.C. §§ 154 and 251, and abhorrent to the U.S. patent system mandated by Art. I, Sec. 8, Cl. 8 of the U.S. Constitution.

Conclusion

The Applicant should be allowed his day before the Board, and ultimately the Federal Circuit if necessary, to argue and receive resolution of the substantive legal issues at hand. Therefore, the Applicant respectfully requests the Commissioner hold the Decision Terminating Proceedings and Notice of abandonment in abeyance pending final substantive resolution on the merits of the pending issues.

Fee Payment (37 C.F.R. §1.17 (h))

- Charge Deposit Account No. 04-1700 in the amount of **\$130.00** for the surcharge fee.

- The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment under 37 C.F.R. 1.16 and 1.17 to Deposit Account No. 04-1700.



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